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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,763	04/26/2005	Matthias Muller	NY-DNAG-300-US	3415
24972	7590	10/30/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP			ADDISU, SARA	
666 FIFTH AVE			ART UNIT	
NEW YORK, NY 10103-3198			PAPER NUMBER	

3722

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/524,763

Applicant(s)

MULLER ET AL.

Examiner

Sara Addisu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2005 and 03 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/3/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This Office Action is in response to the amendment filed 8/3/06. New claims 68-71 have been added. Currently, claims 11-71 are pending in this application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 67 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 recites, "a cutting tool comprising a cutting plate according to claim 11". It is not clear how the limitation of claim 67, further limits claim 11. For the purpose of this Office Action, Examiner assumes that it is the same limitation.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-17, 19-35, 37-46, 68-71 are rejected under 35 U.S.C. 102(b) as being anticipated by Ukegawa et al. (USP 6,017,172).

Regarding claims 11 and 68, UKEGAWA ET AL. teaches a cutting plate comprising an upper side, cutting edge, a first clamping trough (2: located on the top side of the insert) for clamping in a cutting tool arranged coaxially with respect to a second clamping trough (2: located on the bottom side of the insert) ('172, figure 1A, 1B). UKEGAWA ET AL. also teaches said first clamping trough (2) has circular recess (5). Said second clamping trough (2) has a flat bottom (5) ('172, figure 1A and col. 3, lines 29-41), therefore the recess (5) extends the depth of the first trough such that it is dimensionally deeper than the second clamping trough (with the flat bottom which is parallel to the cutting plate upper side). Regarding claims 12, 17 and 20-22, UKEGAWA ET AL. teaches in figures 1A and 1B, both clamping troughs having a round shape. Regarding claims 13 and 14, UKEGAWA ET AL. teaches the first trough forming a surface that is trough shaped. Regarding claims 15, 16, 19, 23-28 and 69, defining the elevation to be measured in a downward direction, UKEGAWA ET AL. teaches the center of the first clamping trough has an elevation (5) that is annular ('172, figure 1A & 1B). Regarding claims 29, 30-35, 37-46, 70 and 71, UKEGAWA ET AL. teaches a ceramic insert.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18, 36 and 47-67, as best understood, are rejected under 35

U.S.C. 103(a) as being unpatentable over Ukegawa et al. (USP  
6,017,172).

UKEGAWA ET AL. teaches a ceramic cutting insert comprising an upper side, cutting edge, a first clamping trough and a second clamping trough, as set forth in the above rejection.

Regarding claim 36, UKEGAWA ET AL. teaches a ceramic insert. Regarding claims 47-65, although UKEGAWA ET AL. does not disclose the fact that the insert is indexable, it is old and known to have indexable inserts for the purpose of increasing the number of cutting edges thus increase the life of the insert and consequently reduce cost. Regarding claim 18, UKEGAWA ET AL. is silent about the shape of the second trough being oval. At the time the invention was made, it would have been an obvious

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matter of design choice to a person of ordinary skill in the art to choose any shape for the trough because Applicant has not disclosed that an oval shaped trough provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with UKEGAWA ET AL.'s trough shape. Regarding claim 66, the claimed phrase " the first and second clamping troughs have been introduced during production by a pressing process", is being treated as a product by process limitation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, UKEGAWA ET AL.'s teaching of the insert having troughs would be the same or similar as that claimed (i.e. troughs being introduced during production by pressing process). Regarding claim 67, UKEGAWA ET AL. teaches a clamp (11).

### ***Response to Arguments***

Applicant's arguments with respect to claims 11-67 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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SA  
10/26/06

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SUPERVISORY PATENT EXAMINER